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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,404	09/24/2003	Viacheslav A. Petrov	UC0318 US NA	5035

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WILMINGTON, DE 19805

EXAMINER

KEYS, ROSALYND ANN

ART UNIT	PAPER NUMBER
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1621

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/26/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/669,404

Applicant(s)

PETROV, VIACHESLAV A.

Examiner

Rosalynd Keys

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6/9/05 & 8/1/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. Claims 1-8 and 10-17 are pending.
Claims 1-8 and 10-17 are rejected.
Claim 9 is cancelled.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 5, 2007 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanechika et al. (US 5,547,593) in view of JP 02227285 A).

Sanechika et al. disclose a lubricant oil composition comprising a compound (A), having the claimed compound structure and a compound (B), which the Examiner considers to be equivalent to the applicants claimed organic active material (see entire disclosure, in particular column 4, line 33 to column 5, line 64; column 35, line 34 to column 38, line 23; column 43, line 6 to column 44, line 41;

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compounds S4, S8, S12 and S13 in columns 55, 57 and 58; examples 17-20 in column 67 and Table 5 ; and example 29 in column 69 and 70). Styrene oligomer is an example of compound (B). JP 02227285 A teaches that styrene oligomer is a buffer layer material (see Derwent abstract).

One having ordinary skill in the art at the time the invention was made would have found it obvious to combine any component A compound, as disclosed by Sanechika et al., including the claimed compound, with any component B compound, as disclosed by Sanechika et al., including a styrene oligomer, which is taught by JP 02227285 A to be useful a buffer layer material, since Sanechika et al. teach that such a combination has use as a lubricant in refrigeration equipment.

MPEP 2111.02 states that:

"The claim preamble must be read in the context of the entire claim. The determination of whether preamble recitations are structural limitations or mere statements of purpose or use "can be resolved only on review of the entirety of the [record] to gain an understanding of what the inventors actually invented and intended to encompass by the claim." Corning Glass Works, 868 F.2d at 1257, 9 USPQ2d at 1966. If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction. Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999). See also Rowe v. Dror, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997) ("where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation"); Kropa v. Robie, 187 F.2d at 152, 88 USPQ2d at 480-81 (preamble is not a limitation where claim is directed to a product and the preamble merely recites a property inherent in an old product defined by the remainder of the claim)." In the instant case, the Examiner believes that the newly added preamble of "for an active layer of an OLED device, is directed to the purpose or intended use of the solution comprising an organic

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active material and a compound having the claimed structure. Thus, the Examiner believes that the preamble is not considered a limitation and is of no significance to claim construction.

5. Claims 1-8 and 10-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Poetsch et al. (US 5,348,677).

Poetsch et al. teach compounds having a formula I, which have the same structural formula as the claimed compound structure (see entire disclosure, in particular column 3, lines 23-66; column 6, line 31 to column 8, line 62; column 9, lines 26-34 and column 17, lines 25-35). Poetsch et al. teach electro-optical liquid crystal display elements containing their formula I compounds (see column 1, line 7 to column 2, line 28).

Poetsch et al. fail to expressly disclose the claimed organic active materials however their use is clearly suggested, i.e., as additives (see column 16, lines 23-40).

One having ordinary skill in the art at the time the invention was made would have found it obvious to combine the claimed organic active materials with the fluorine containing compounds of Poetsch et al. for use in liquid crystal display elements, since Poetsch et al. teach that their liquid-crystalline dielectrics can be modified by suitable additives in a such a way that they can be used in all of the disclosed types of liquid crystal display elements (see column 16, lines 23-26).

Poetsch et al. fail to expressly disclose the compounds of claim 6. However, Poetsch et al. suggest the compounds of claim 6 and the compounds expressly disclosed in example 1 of Poetsch et al. have close structural similarity and similar utility as the compounds of claim 6. Thus, the compounds of claim 6 are prima facie obvious over the compounds disclosed by Poetsch et al.

Again the Examiner wishes to direct the applicant's attention to MPEP 2111.02 (see above). The Examiner believes that the newly added preamble of "for an active layer of an OLED device, is directed to the purpose or intended use of the solution comprising an organic active material and a compound having the claimed structure. Thus, the Examiner believes that the preamble is not considered a limitation and is of no significance to claim construction.

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Double Patenting

6. The rejection of claims 1-4 provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 15 of copending Application No. 10/669,403 is withdrawn.

Terminal Disclaimer

7. The terminal disclaimer filed on December 1, 2005 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of Application No. 10/669,403 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Response to Arguments

8. Applicant's arguments filed February 5, 2007 have been fully considered but they are not persuasive.

The Applicants argue that the JP '7285 reference discloses only "styrene oligomer" as a component in the buffer layer and neither Sanechika nor JP '7285 teach whether a substituted styrene has buffer properties. These arguments are not persuasive. The JP '7285 reference discloses a styrene oligomer as one of the materials suitable for use as the buffer layer in its optical card and not simply as a component in the buffer layer. The Examiner concluded that since the JP '7285 reference disclosed a styrene oligomer as a suitable material for the buffer layer that the styrene oligomer must have buffer properties. With respect to Sanechika, the Examiner offers that while there must be motivation to make the claimed invention, there is no requirement that the prior art provide the same reason as the applicant to make the claimed invention. Thus, whether Sanechika recognizes that a styrene oligomer is a buffer layer material is irrelevant, since the claims are directed to a solution comprising the claimed fluoroaromatic compound and a buffer layer material and Sanechika teaches a lubricating composition which may comprise the claimed fluoroaromatic compound and a styrene oligomer, which is a known buffer layer material, as taught by the JP '7285 reference.

The Applicants argue that Sanechika is altogether silent as to organic active materials as constituting Component B, and J'P '7285 is silent as to whether the styrene oligomer recited therein as a

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buffer layer component may be alkyl substituted in the manner shown in Sanechika. Therefore, it is not absolutely clear that Sanechika does, in fact, disclose a styrene oligomer that would be suitable as a buffer material, nor does JP '7285 expressly limit its oligomer to a dimer, trimer or tetramer as does Sanechika. This argument is not persuasive because the Examiner believes as stated earlier that Sanechika teaches the use of styrene oligomer as a component B (see column 35, lines 10-16), which is taught to be a buffer layer material by J'P '7285 (see DERWENT abstract). The Examiner believes that the reference to a styrene oligomer in both JP '7285 and Sanechika is a general teaching that includes any styrene oligomer, substituted or unsubstituted. Thus, unless shown otherwise the Examiner concluded that any styrene oligomer, including the styrene oligomer disclosed by Sanechika, would be suitable as the buffer layer in the optical card of J'P '7285.

The Applicant further respectfully asserts that even if the styrene oligomer in Sanechika would be a suitable buffer, this reference does not enable any of the pending claims, and therefore does not anticipate the invention. This argument is not persuasive because a reference is presumed operable until applicant provides facts rebutting the presumption of *operability*. In re Sasse, 629 F.2d 675, 207 USPQ 107 (CCPA 1980). Therefore, applicant must provide evidence showing that a process for making was not known at the time of the invention. As far as the Examiner is concerned Sanechika does enable the claimed invention, since Sanechika discloses a lubricant composition which includes an organic active material, in particular a styrene oligomer, which is known to be useful as a buffer layer material, and a compound having the claimed structure.

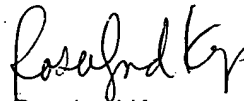
For the above reasons, the Examiner believes that the instant claims are not patentable.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosalyn Keys whose telephone number is 571-272-0639. The examiner can normally be reached on M, W & F 5:30-7:30 am & 1-5 pm; T & Th 5:30 am-4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Rosalyn Keys
Primary Examiner
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February 15, 2007